

Introduction of certification marks and other amendments to Trademark Law

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Introduction

Parliament recently transposed parts of EU Directive 2015/2436 into national law (*Federal Law Gazette I 2017/124*), which introduced several new provisions into Austrian trademark law. Most important is the introduction of certification marks, which did not previously exist under Austrian law. Other provisions of the bill concern:

- the division of trademark applications;
- the shortening of the validity period of a registration; and
- the reduction of the registration fee.

Certification marks

The newly created Section 63a(1) of the Trademark Act, which almost verbatim adopts Article 27(a) of the directive, states that certification marks can be registered in order to distinguish goods and services which are certified by the owner of the mark in respect of material, modes of manufacturing goods or performing services, quality, accuracy or other characteristics, except geographical origin, from goods and services which are not so certified.

According to Paragraph 2 a certification mark may be registered only by a person who does not carry on a business involving the supply of goods or services of the kind for which the certification mark is to be registered. This rule, which should guarantee some form of objectivity and neutrality, marks a difference to collective marks, which allow a closer economic relationship between the owner of the trademark and the suppliers of the goods and services using the trademark.

The applicant of a certification mark must provide a charter detailing:

- the characteristics and properties certified by the mark;
- the conditions of use of the mark, including penalties; and
- a system for examining the certified properties and supervising the use of the mark.

Section 66a provides for the deletion of the certification mark if the owner of the mark does not take appropriate measures to prevent the use of the mark in violation of said charter or if such use is misleading.

Division of applications and registrations

In accordance with Article 41 of the directive, Section 23a of the Trademark Act enables applicants

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and owners of trademarks to divide a trademark application or registration into two or more separate applications or registrations (technically the trademark itself is not divided but rather the goods or services for which the trademark is being registered).

The only condition – besides payment of a fee – is that the applicant or owner declares which goods and services formally covered by the original trademark application will be covered by the divisional application or registration. The idea behind dividing a trademark is that it allows an applicant to proceed with parts of an application (ie, with the registration for some goods or services) if the attempt to register the trademark might otherwise fail with regard to certain other goods or services.

Duration of registration

According to Article 48 of the directive, the registration period for trademarks is 10 years from the date on which the application is filed. Until now, the registration period in Austria has been calculated from the end of the month in which the trademark was registered (usually a few months after filing of the application). While ongoing 10-year registration periods will not be affected by the amendment, renewals will be calculated from the filing date of the original application. Thus, the first renewal period following a renewal will be slightly shorter than 10 years. Accordingly, fees for the renewal will be reduced.

Reduction of registration fees

Since Austria's trademark registration fees were considered rather high, the bill reduces the registration fee to €304 (€284 in case of an online application) for individual trademarks and €484 (€464 in case of an online application) for collective and certification marks. These fees include three classes of goods and services; every further class will cost €75.

Comment

The bill is a further step towards harmonising Austrian and European trademark law. In particular, the introduction of certification marks and the possibility of dividing trademark applications and registrations – both previously unknown in Austria – provide new opportunities. The reduction of registration fees is obviously more than welcome considering that Austrian fees were among the highest in Europe. In future, the harmonisation of registration periods will facilitate the management of trademarks; the drawback that the first renewal period will be slightly shorter than 10 years seems worth it.

However, this bill has not yet completely transposed EU Directive 2015/2436 into Austrian law; thus, further amendments to the Trademark Act can be expected – in particular, the requirement of graphical representation of a trademark, still in force in Austria, will have to be abandoned by January 14 2019.

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